

Application No.: 09/828,764

Docket No.: 99-808 RCE3

REMARKS

As a preliminary matter, Applicant has treated the office action as being non-final since box (2b) of the Office Action Summary indicates that is non-final. Page 5, paragraph 15, suggests that the Examiner had at one point intended to make the office action final, but apparently changed his mind. Moreover, to the extent that there are inconsistent positions, pursuant to MPEP §707.07 the office action lacks completeness and clarity, requiring a further office action in any event. Even various attempts to query the PAIR system while this response was being prepared to clarify the status of the application were unsuccessful, apparently as a result of an ongoing move to the new Patent Office facilities. Finally, Applicant notes that this response is being filed within two months of the date of the office action.

The following remarks are intended to be fully responsive to the Office Action having a mailing date of June 27, 2005 wherein claims 6-8, 10-12, 14-17, 19-21 and 23-25 have been rejected. Claims 9 and 18 are objected to as being a substantial duplicate of claims 26 and 27. Claims 26 and 27 are allowed. Applicant submits that no new matter has been added by this amendment and that support for the amendment may be found throughout the specification and drawings.

Claim Objections

Claims 9 and 18 are objected to under 37 CFR §1.75 as being a substantial duplicate of claims 26 and 27. Applicant respectfully traverses.

The Examiner will notice that the claim 26 does not include the limitation of "forming a banner ad term list, each element in said banner ad term list including terms of said first supercategory and terms of said at least one category associated with said first supercategory;..." as does claim 9 (due to its dependency on claim 6). Likewise, claim 27 does not include the limitation of "machine executable code for forming a banner ad term list, each element in said banner ad term list including terms of said first supercategory and terms of said at least one category associated with said first supercategory;..." as does claim 18 (due to its dependency on claim 15). Accordingly, claims 9 and 18 are not substantially the same as claims 26 and 27, respectively. As such, Applicant respectfully requests that this objection be withdrawn.

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35 U.S.C. § 103Claim Rejections Using *Herz et al.* in view of *Kramer et al.*

Claims 6-8, 10-12, 14-17, 19-21 and 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Herz et al.*, U.S. Patent No. 5,754,938 in view of *Kramer et al.*, U.S. Patent No. 6,327,574. Applicant respectfully traverses this rejection.

Independent claims 6, 15 and 24 recite method and apparatus claims directed toward a computer system for targeting advertisements that includes, among other things, “forming a banner ad term list, each element in said banner ad term list including terms of said first supercategory and terms of said at least one category associated with said first supercategory.”

As admitted to by the Examiner (page 3, paragraph 7 of the Office Action), and argued by Applicant, neither *Herz et al.* nor *Kramer et al.*, either standing alone or in combination, teach or suggest a method (or apparatus) for targeting advertisements that includes a limitation of “forming a banner ad term list as according to embodiments recited in independent claims 6, 15, and 24.” Without a teaching or suggestion of such a limitation the claims as amended, as well as their dependent claims are patentable.

Herz et al. teaches a system and method for customized electronic identification of desirable objects, such as news articles, in an electronic media environment. *Herz et al.* also teaches target profile for the objects and a target profile interest summary for each user. The system then evaluates the target profiles against the users' target profile interests summaries to generate a user customized rank ordered listing of target objects most likely to be of interest to the user without requiring the user to expend an excessive amount of time and energy (Col. 5, lines 5-29; Col. 4, lines 38-41).

Kramer et al. teaches the modeling of consumer attribute vectors for targeting content in a privacy preserving manner. According to *Kramer et al.*, consumer profiles are developed and maintained with information reflecting the consumer's online and offline transactions. The consumer profiles include hierarchical attribute vectors which encode attributes of a consumer at progressively higher levels of abstraction. Documents delivered to

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the consumer may be customized for the particular preferences of the consumer based on the attribute vectors (See Abstract; Col. 2, line 56 through Col. 3, line 9).

To establish a *prima facie* case of obviousness, the Examiner must show that the combined references teach or suggest each and every limitation of the claims (See MPEP §2143; *In re Vaeck*, 947 F.2d 488, 493; 20 USPQ2d 1438, 1444 (Fed. Cir. 1991)). The Examiner admits in paragraph 7 of the Office Action that neither the *Herz* reference nor the *Kramer et al.* reference teach "forming a banner ad term list, each element in said banner ad term list including terms of said first supercategory and terms of said at least one category associated with said first supercategory," as recited in claims 6, 15 and 24. Yet the Examiner continues to reject claims 6, 15 and 24 on the basis that "a 'banner ad term list' is the most obvious means for associating a banner ad with search terms," with no support for such assertion other than the Examiner's personal "knowledge." Applicant submits that the Examiner has not met the requirements for a *prima facie* case of obviousness, as the Examiner's conclusory remarks as to what the Examiner considers to be "common knowledge" in the art do not have evidentiary support in the record, and therefore cannot be the principal evidence upon which a rejection was based. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

In view of the Examiner's admission, and Applicant's arguments, neither *Herz et al.* nor *Kramer et al.*, either standing alone or in combination, teach or suggest a method (or apparatus) for targeting advertisements that includes a limitation of "forming a banner ad term

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list, each element in said banner ad term list including terms of said first supercategory and terms of said at least one category associated with said first supercategory." Applicant disagrees with the Examiner's assertion that such a limitation was "common knowledge," and no evidence has been provided by the Examiner to support such an assertion, as is required.¹ (See MPEP §2144.03) Accordingly, Applicant respectfully requests that the pending claims be passed to issue.

ALLOWABLE SUBJECT MATTER

Claims 26 and 27 are allowed.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the pending claims are in condition for allowance each of the presently pending claims in this application is believed to be in immediate condition for allowance. Reconsideration and allowance are respectfully requested. If there are outstanding issues which need to be resolved to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned representative by phone at the number indicated below to discuss such issues. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should be charged to deposit account number 07-2347. With respect to this application, please charge any other necessary fees and credit any overpayment to that account.

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Respectfully submitted,

By 

Joseph R. Palmieri, Reg. No.: 40,760
Verizon Corporate Services Group Inc.
600 Hidden Ridge Drive, Mailcode HQE03H14
Irving, TX 75038
Customer No.: 32127
Telephone: 972-718-4800

¹ In fact, the Examiner has requested that Applicant provide a declaration with certain assertions to traverse the Examiner's argument concerning the banner ad term list. (Office Action, ¶ 10.) Leaving aside that the declaration requested by the Examiner would have no legal bearing on whether Applicant's claims are patentable over the cited references, this request is improper as it effectively shifts the burden away from the Examiner to establish a *prima facie* case of obviousness, as required under the law.